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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT: Reinhold Schopf

SERIAL NO. 09/928,070

FILED: August 10, 2001

FOR: STYLES AND METHOD OF FORMING SAME

EXAMINER: Yaritza Guadalupe Group: 2839

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandra, VA 22313-1450

REPLY BRIEF

Sir:

This is Appellant's Brief in reply to the Examiner's Answer dated January 13, 2004.

- A. Kendall does not disclose a stylus with a diameter of the stylus stem in the break-off region remaining substantially unchanged.**

The Examiner rejects Claims 8-10 under 35 U.S.C. §102(b) as being anticipated by Kendall, U.S. Patent No. 4,826,372 (Kendall). The Examiner asserts that in Kendall, the break-off region/breakneck region (24) of the stem (14) has a stem diameter substantially unchanged, *i.e.*, the Examiner asserts that the diameter of the breakneck region (24) is substantially equal to the diameter of the stem (14) and, therefore, Kendall discloses a limitation of Claim 8 of the instant application that “a diameter of the stem in the break-off region remains substantially unchanged.”

The issue in this regard is what “substantially” means. According to a dictionary definition, “substantially” means “being largely but not wholly that which is specified” (Merriam-Webster’s Collegiate Dictionary, Tenth Edition, 1998). The case law holds that “substantially” is interpreted as how one of ordinary skill in the art would understand the term in view of general guidelines contained in the specification. Andrew Corp. v. Gabriel Electronics, 6 U.S.P.Q. 2d 2010 (Fed. Cir. 1988).

The specification discloses that the diameter of the stem does not change or changes only insignificantly (page 10, lines 8-9) and explains what the change may be.

The specification discloses that the changes of the structure of material in the break-off region is effected by heating. Thus, the of diameter, if any, would only be the result of heating, which does not change the dimension in any noticeable manner. With a penetration depth of .2 mm, the change of the diameter, if any, would be at most a tenth of that amount, *i.e.*, about .02 mm with the stem diameter of 2 mm (page 10, line 10), that change would amount to 1%. Thus, one of ordinary skill in art, reading the specification, would understand that “substantially” means a change in diameter of the stem in the break-off region of about 1%.

Kendall claims that the breakneck diameter is approximately 85% of the first shank section (the stem) (Claim 28). Thus, the change in the diameter of the break-off region from that of the stem is 15%. It is respectfully submitted that 15% cannot be interpreted substantially the same. The Examiner states that because the term “substantially” has not been defined in the specification and because appellant provides one example of the change of diameter, the term “substantially” can be interpreted broadly and that 15% change also can be considered substantially unchanged (Examiner’s answer, the paragraph bridging pages 6-7).

Appellant respectfully submits that the present specification provides ample evidence of what “substantially” means with regard to the claimed subject matter.

In view of the above, it is respectfully submits that Kendall does not disclose or even remotely suggests a stylus having a stem diameter of its break-off region substantially unchanged (in comparison with the stem diameter in other regions).

B. Kendall does not disclose a stylus having a break-off region provided in the stem and consisting of a changed structure of a stem material.

The Examiner states that “a changed structure of stem material” could be interpreted as either a change in a physical or chemical characteristic of the stem, that the change of a structure of the stem material has been interpreted, by the Examiner, as a change in shape in the structure, and that Kendall, thus, discloses a stem structure (14) that has been physically changed (Examiner’s Answer, page 7, paragraph “B”).

It is noted that the Examiner refers to a change of stem structure in Kendall not to a change in the stem material structure.

Appellant respectfully submits that the Examiner's interpretation of "changed structure of stem material" as a physical characteristic is not tenable.

It is noted that generally under "material," one of ordinary skill in the art would understand a substance from which something is made. A material does not have a predetermined shape that can be changed. Under "structure of material," one of ordinary skill in the art would unambiguously understand a crystalline structure of a material and not the material physical shape. Kendall does not disclose a change in the structure of the material of the stem.

In view of the foregoing, it is respectfully submitted that Kendall does not anticipate or makes obvious the present invention, as defined in Claim 8, and Claim 8 is patentable over Kendall.

Claims 9-10 depend on Claim 8 and are likewise patentable.

Claim 13 is directed to a coordinate-measuring machine with a stylus of Claim 8 and is patentable for the same reason Claim 8 is patentable.

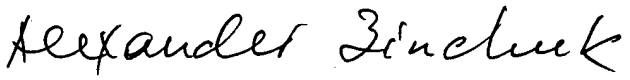
Claims 14-15, which depend on Claim 13, are also patentable.

CONCLUSION

Appellant respectfully submits that the Examiner's rejection of Claims 8-10 as being anticipated by Kendall and Claims 13-15 as being unpatentable over Possatti, et al. in view of Kendall is not supported by the disclosure of Kendall and/or Possatti. Therefore, appellant respectfully requests that the Examiner's rejection of Claims 8-10 as anticipated by Kendall and the rejection of Claims 13-15 as being unpatentable over Possatti, et al., in view of Kendall be reversed.

This Reply Brief is being submitted in triplicate.

Respectfully Submitted,


Alexander Zinchuk, Reg. No. 30,541

Dated: March 3, 2004
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7365

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 3, 2004.

Alexander Zinchuk

Signature: 

ADDENDUM TO APPENDIX "B"

5. Andrew Corp. v. Gabriel Electronics, 6 U.S.P.Q. 2d 2010
(Fed. Cir. 1988).

In *Verve, LLC v. Crane Cams, Inc.*, ___ F.3d ___, App. No. 01-1417 (Fed. Cir. Nov. 14, 2002)(Newman, J.), *opinion below*, 145 F. Supp.2d 862, 60 USPQ2d 1219 (E.D. Mich. 2001), a panel of the Federal Circuit distinguishes *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1218 (Fed. Cir. 1991)(Lourie, J.) (holding a claim invalid for indefiniteness at the point of novelty), vacating and remanding a summary holding of invalidity based upon indefiniteness under 35 USC § 112, ¶ 2.

Terms lacking precise boundaries from within the intrinsic evidence of a patent have been basis for a finding of invalidity under 35 USC § 112, ¶ 2, under *Amgen*. Judge Newman distinguishes *Amgen* under the facts of this particular case as follows:

"The [trial] court recognized that the usage 'substantially' may be adequately definite in some cases, but ruled that in this case it was indefinite because it was not further defined. The court cited *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1218, 18 USPQ2d 1016, 1031 (Fed. Cir. 1991), for its statement that 'When the meaning of claims is in doubt, especially when, as is the case here, there is close prior art, they are properly declared invalid.'

"We conclude that the court erred in law, in requiring that the intrinsic evidence of the specification and prosecution history is the sole source of meaning of words that are used in a technologic context. While reference to intrinsic evidence is primary in interpreting claims, the criterion is the meaning of words as they would be understood by persons in the field of the invention. Patent documents are written for persons familiar with the relevant field; the patentee is not required to include in the specification information readily understood by practitioners, lest every patent be required to be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Thus resolution of any ambiguity arising from the claims and specification may be aided by extrinsic evidence of usage and meaning of a term in the context of the invention. The question is not whether the word 'substantially' has a fixed meaning as applied to 'constant wall thickness,' but how the phrase would be understood by persons experienced in this field of mechanics, upon reading the patent documents. It may of course occur that persons experienced in a technologic field will have divergent opinions as to the meaning of a term, particularly as narrow distinctions are drawn by the parties or warranted by the technology. Patent disputes often raise close questions requiring refinement of technical definitions in light of particular facts. The judge will then be obliged to decide between contending positions; a role familiar to judges. But the fact that the parties disagree about claim scope does not of itself render the claim invalid.

"Expressions such as 'substantially' are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to 'particularly point out and distinctly claim' the invention, 35 U.S.C. §112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988) the court explained that usages such as 'substantially equal' and 'closely approximate' may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that 'like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995).

"It is well established that when the term 'substantially' serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite. Understanding of this scope may be derived from extrinsic evidence without rendering the claim invalid. The summary judgment record offered no basis for departing from these general rules. Thus the usage 'substantially constant wall thickness' does not of itself render the claims *** indefinite. The summary judgment on this ground is vacated; we remand for further proceedings, including any appropriate recourse to extrinsic evidence concerning the usage and understanding of the term 'substantially' in relevant context."

REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE

A claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited “said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for” was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). On the other hand, a claim limitation specifying that a certain part of a pediatric wheelchair be “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats” was held to be definite. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). The court stated that the phrase “so dimensioned” is as accurate as the subject matter permits, noting that the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

A. “About”

The term “about” used to define the area of the lower end of a mold as between 25 to about 45% of the mold entrance was held to be clear, but flexible. *Ex parte Eastwood*, 163 USPQ 316 (Bd. App. 1968). Similarly, in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the court held that a limitation defining the stretch rate of a plastic as “exceeding about 10% per second” is definite because infringement could clearly be assessed through the use of a stopwatch. However, the court held that claims reciting “at least about” were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term “about.” *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991).

B. “Essentially”

The phrase “a silicon dioxide source that is essentially free of alkali metal” was held to be definite because the specification contained guidelines and examples that were considered sufficient to enable a person of ordinary skill in the art to draw a line between unavoidable impurities in starting materials and essential ingredients. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (CCPA 1983). The court further observed that it would be impractical to require applicants to specify a particular number as a cutoff between their invention and the prior art.

C. “Similar”

The term “similar” in the preamble of a claim that was directed to a nozzle “for high-pressure cleaning units or similar apparatus” was held to be indefinite since it was not clear what applicant intended to cover by the recitation “similar” apparatus. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

A claim in a design patent application which read: “The ornamental design for a feed bunk or similar structure as shown and described.” was held to be indefinite because it was unclear from the specification what applicant intended to cover by the recitation of “similar structure.” *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992).

D. “Substantially”

The term “substantially” is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation “to

substantially increase the efficiency of the compound as a copper extractant” was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation “which produces substantially equal E and H plane illumination patterns” was definite because one of ordinary skill in the art would know what was meant by “substantially equal.” *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

E. “Type”

The addition of the word “type” to an otherwise definite expression (e.g., Friedel-Crafts catalyst) extends the scope of the expression so as to render it indefinite. *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955). Likewise, the phrase “ZSM-5-type aluminosilicate zeolites” was held to be indefinite because it was unclear what “type” was intended to convey. The interpretation was made more difficult by the fact that the zeolites defined in the dependent claims were not within the genus of the type of zeolites defined in the independent claim. *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986).

F. Other Terms

The phrases “relatively shallow,” “of the order of,” “the order of about 5mm,” and “substantial portion” were held to be indefinite because the specification lacked some standard for measuring the degree intended and, therefore, properly rejected as indefinite under 35 U.S.C. 112, second paragraph. *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992).

The term “or like material” in the context of the limitation “coke, brick, or like material” was held to render the claim indefinite since it was not clear how the materials other than coke or brick had to resemble the two specified materials to satisfy the limitations of the claim. *Ex parte Caldwell*, 1906 C.D. 58 (Comm’r Pat. 1906).

The terms “comparable” and “superior” were held to be indefinite in the context of a limitation relating the characteristics of the claimed material to other materials - “properties that are superior to those obtained with comparable” prior art materials. *Ex parte Anderson*, 21 USPQ2d 1241 (Bd. Pat. App. & Inter. 1991). It was not clear from the specification which properties had to be compared and how comparable the properties would have to be to determine infringement issues. Further, there was no guidance as to the meaning of the term “superior.”

2173.05(c) Numerical Ranges and Amounts Limitations

Generally, the recitation of specific numerical ranges in a claim does not raise an issue of whether a claim is definite.

I. NARROW AND BROADER RANGES IN THE SAME CLAIM

Use of a narrow numerical range that falls within a broader range in the same claim may render the claim indefinite when the boundaries of the claim are not discernible.

Description of examples and preferences is properly set forth in the specification rather than in a single claim. A narrower range or preferred embodiment may also be set forth in another independent claim or in a dependent claim. If stated in a single claim, examples and preferences lead to confusion over the intended scope of the claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under 35 U.S.C. 112, second paragraph should be made. The Examiner should analyze whether the metes and bounds of the claim are clearly set forth. Examples of claim language which have been held to be indefinite are (A) “a temperature of between 45 and 78 degrees Celsius, preferably between 50 and 60 degrees Celsius”; and (B) “a predetermined quantity, for example, the maximum capacity.”

While a single claim that includes both a broad and a narrower range may be indefinite, it is not improper under 35 U.S.C. 112, second paragraph to present a dependent claim that sets forth a narrower range for an element than the range set forth in the claim from

FULL TEXT OF CASES (USPQ FIRST SERIES)

In re MATTISON AND SWANSON, 184 USPQ 484 (CCPA 1975)

In re MATTISON AND SWANSON

(CCPA)

184 USPQ 484

Decided Jan. 23, 1975

No. 74-568

U.S. Court of Customs and Patent Appeals

Headnotes

PATENTS

1. Claims — Indefinite — In general (§ 20.551)

**Construction of specification and claims — By specification and drawings — In general _
(§ 22.251)**

Words and phrases (§ 70.)

Use of "substantially increase" in claims does not render them indefinite under second paragraph of 35 U.S.C. 112 since phrase does not stand in a vacuum but must be read in light of specification; so read, one skilled in the art can determine scope of claimed invention in terms of a specified percentage value.

Particular patents—Compound

Mattison and Swanson, Substituted 2-Hydroxybenzophenoxime Compounds, rejection of claims 1 and 3 to 5 of application reversed.

Case History and Disposition:

Appeal from Board of Appeals of the Patent Office.

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Application for patent of Phillip L. Mattison and Ronald R. Swanson, Serial No. 714,040, filed Mar. 18, 1968; Patent Office Group 126. From decision rejecting claims 1 and 3 to 5, applicants appeal. Reversed.

Attorneys:

JESSE B. GROVE, JR., Washington, D. C. (GENE O. ENOCKSON, Minneapolis, Minn., of counsel) for appellants.

JOSEPH F. NAKAMURA (FRED E. MCKELVEY of counsel) for Commissioner of Patents.

Judge:

Before MARKEY, Chief Judge, and RICH, BALDWIN, LANE, and MILLER, ASSOCIATE JUDGES.

Opinion Text

Opinion By:

BALDWIN, Judge.

This appeal is from the decision of the Patent Office Board of Appeals, adhered to on reconsideration, sustaining the examiner's rejection of claims 1 and 3 to 5 of appellants' application. ¹Claims 7-10 have been allowed. We reverse.

The Invention

Appellants' invention relates to a new class of substituted 2-hydroxybenzophenoxime compounds which are effective extractants for copper values from aqueous solutions at low pH.

It was previously discovered that copper values could be recovered economically from certain aqueous leach liquors by using a liquid ion exchange process employing particular phenolic oximes as the extractants. ²

While prior phenolic oximes were found to be effective as copper extractants over a wide pH range, their extraction efficiency drops off considerably when the aqueous copper containing solutions have pH's below about 1.5 and especially below 1.0. This represents an important consideration, for certain leach liquors have very low pH's or develop low pH's on being subjected to liquid ion exchange extraction. Appellants have discovered new compounds which have the property of effective copper extraction from aqueous solutions thereof at low pH.

The appealed claims read:

1. A compound of the formula

Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

in which R and R_q may be individually alike or different and are saturated aliphatic hydrocarbon groups of 1-25 carbon atoms, E is an electron withdrawing substituent, p is 1, 2, 3 or 4, m is 0 or a whole integer up to 4-p and n is 0, 1, 2, 3 or 4, said compound having a total of 3-25 carbon atoms in R_m and R_n and said electron withdrawing substituent E_p (1) having an electron withdrawing capacity such that a phenol containing only said substituent has an acid ionization constant K_a of at least about 50 x 10⁻¹⁰ and (2) being so selected and positioned on the aromatic ring to substantially increase the efficiency of the compound as a copper extractant from aqueous solutions having a pH of less than about 1.0.

3. A compound according to claim 1 in which R_q is a branched chain aliphatic hydrocarbon group.
4. A compound according to claim 1 in which R is a branch chain aliphatic hydrocarbon group.
5. A compound according to claim 1 in which the electron withdrawing substituent is a nitro group.

The Rejections

Claims 1 and 3-5 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite by reason of the language "substantially increase the efficiency of the compound as a copper extractant." As stated by the board:

How much is a substantial increase? Is it 3%, 30%, 300%, or something else? Since the answer to this question must be known in order to determine whether a particular compound is or is not within the scope of the subject matter claimed, we hold that the claims are indefinite and accordingly affirm the rejection based on the second paragraph of 35 U.S.C. 112.

Further, the board found that the specification failed to comply with the first paragraph of 35 U.S.C. 112 for its alleged failure to con

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tain a written description of the invention being claimed. More specifically, the board stated:

We have carefully considered the examiner's arguments and we affirm the rejection on the sole ground that the specification fails to teach what is meant by a *substantial increase* in efficiency as a copper extractant. In brief, we fail to find in the specification a written description of the invention being claimed.

While the specification does teach one of ordinary skill in the art how to make and use compounds of the type defined by the claims, while it is sufficient to teach one of ordinary skill how to determine whether the Ka value is that required by the claims, and while it is sufficient to teach one of ordinary skill how to test compounds for their ability to extract copper, it does not tell workers in the art how to interpret the data once it has been obtained. For example, in the event two compounds each meeting all the other requirements of the claims provide an increase in copper extraction of 3% and 30%, respectively, one cannot determine from a reading of the specification whether either or both of these compounds is the invention "described".

Opinion

[1] The board has determined that the limitation "to substantially increase the efficiency of the compound as a copper extractant from aqueous solutions having a pH of less than about 1.0" renders the claims unpatentable under 35 U.S.C. 112, second paragraph, as not particularly pointing out and distinctly claiming the invention. We disagree.

The board concedes that the claims are directed to what applicants regard as their invention.³ The basis for the rejection is that the claims are indefinite by reason of the language "substantially increase the efficiency of the compound as a copper extractant."

The criticized phrase found in claim 1 does not stand in a vacuum. See *In re Moore*, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (1971). Claim 1 further requires that the substituent Ep has an electron withdrawing capacity such that a phenol containing only the substituent Ep has an acid ionization constant K_a of at least 50×10^{-10} . The claims must be read in light of the specification. In *re Cohn*, 58 CCPA 996, 438 F.2d 989, 169 USPQ 95 (1971); In *re Moore*, supra. The specification teaches how the electron-withdrawing substituents must be selected and positioned on the ring in order to provide the desired increase in extraction efficiency at the low pH ranges. In addition to the requirement that the substituent Ep must provide substituted phenols with acid ionization constants of about 50×10^{-10} or higher, ⁴it is stated that the electron withdrawing group should not adversely affect the solubility or stability of the benzophenoxime, sterically hinder the OH group, ⁵or cause interfering side reactions. Further, appellants disclose that the electron withdrawing substituents should not interfere in the extraction process by complexing or reacting with the acid of the low pH copper-containing solution. ⁶

We are not persuaded by the board's reasoning that one skilled in the art would not be able to determine the scope of the claimed invention in terms of a specified percentage value. General guidelines are disclosed for a proper choice of the substituent Ep together with a representative number of examples. If the prior art 2-hydroxybenzophenoxime is modified by the inclusion of an electron withdrawing substituent Ep as claimed, resulting in substantially increased efficiency of the compound as a copper extractant from aqueous solutions having a pH of less than 1.0, the compound is within the scope of the claims. ²Hypothesizing whether an increase in efficiency of 3%, 30%, or 300% is necessary for said increase to be classified as substantial is not determinative of the issue of whether the claims satisfy 35 U.S.C. 112, second paragraph.

Similarly, we hold that the specification satisfies the requirements of the first paragraph of 35 U.S.C. 112. The rejection under the first paragraph of § 112 is not for insufficiency of

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disclosure to enable practice of the invention, but for lack of a written description of the invention. With respect to this rejection, it is sufficient to note that language virtually identical to that objected to for indefiniteness under the second paragraph of § 112 appears in the written description and is as broad as that used in appellants' broadest claims. In *re Robins*, 57 CCPA 1321, 1325, 429 F.2d 452, 456, 166 USPQ 552, 555 (1970).

Therefore, the board's decision is *reversed*.

Footnotes

Footnote 1. Serial No. 714,040, filed March 18, 1968.

Footnote 2. The phenolic oximes used prior to the present invention were those having the following basic structure:
Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.

R and R ϕ are saturated aliphatic, ethylenically unsaturated aliphatic or saturated or ethylenically unsaturated aliphatic ether groups and m and n are 0, 1, 2, 3 or 4. The phenolic oximes contain 3 to 25 carbon atoms in the R and R ϕ groups, the latter being of 1 to 25 carbon atoms when saturated and 3 to 25 carbon atoms when ethylenically unsaturated.

Footnote 3. The board stated:

We find no indication in the record that appellants are not claiming what they regard as their invention; nor has such an issue been raised.

Footnote 4. Appellants disclose that if a chloro group is selected, it must be positioned in at least one position other than para to the hydroxyl group. Otherwise, it does not provide the necessary Ka value.

Footnote 5. Appellants disclose that bulky substituents, e.g., -SF 5, should not be in the ortho position since they will sterically hinder the OH group.

Footnote 6. Appellants disclose that substituents such as NH 2 should be avoided, as such groups complex or react with acids.

Footnote 7. It is interesting to note that the board found it unnecessary to consider the scope of the word "substantially" in its holding that the claims are patentable over art cited by the examiner. The board thus stated:

Such reliance is not inconsistent with our holdings on the section 112 rejections since a given expression, though not precisely worded, may nevertheless convey a general concept neither taught nor suggested by prior art disclosures. Thus, as here, a "substantial" increase clearly is distinct from no increase at all; yet the amount of increase necessary to qualify as "substantial" is unknown. Appellants' Examples are of little assistance since a wide variance in this regard is there shown.

- End of Case -

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